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EXAMINER

PADMANABHAN, KAVITA

ART UNIT

PAPER NUMBER

2161

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/26/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

10/786,705

Applicant(s)

JUNG ET AL.

Examiner

Kavita Padmanabhan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 15 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-95 is/are pending in the application.
- 4a) Of the above claim(s) 24-47 and 71-94 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23, 48-70 and 95 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-646)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 2/15/07
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Status of Claims***

1. Claims 1-95 are pending.
2. Claims 24-47 and 71-94 have been withdrawn.
3. Claims 1, 5, 17, 48, 52, 64, and 95 have been amended.
4. Claims 1-23, 48-70, and 95 are rejected.

### ***Election/Restrictions***

5. Applicant's election with traverse of Group I, claims 1-23, 48-70, and 95, in the reply filed on 2/15/07 is acknowledged. The traversal is on the ground(s) the examination of group II would not place an additional serious burden on the Examiner because undue diverse searching would not be required. This is not found persuasive because of reasons of record, including because the two groups are directed towards different inventions whose claims have different limitations and would indeed require different searches. Furthermore, MPEP 802.02 states in part, "the examiner, in order to establish reasons for insisting upon restriction, must explain why there would be a serious burden on the examiner if restriction is not required. Thus the examiner must show by appropriate explanation one of the following: (A) Separate classification thereof", "(B) A separate status in the art when they are classifiable together", and "(C) A different field of search". In the present case, not only would the two groups require different searches, they are also classified separately. The requirement is still deemed proper and is therefore made FINAL.

6. This application contains claims 24-47 and 71-94 drawn to an invention nonelected with traverse in Paper No. 20061107. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

*Claim Objections*

7. **Claims 5 and 52** are objected to because of the following informalities:
- Claims 5 and 52** contain the acronym "IMEI," which should be spelled out in the claims. Appropriate correction is required.

*Claim Rejections - 35 USC § 112*

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:
- The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
9. **Claims 17 and 64** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation "IEEE 802.15.1" does not appear to be supported by the applicant's original disclosure.
10. The following is a quotation of the second paragraph of 35 U.S.C. 112:
- The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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11. **Claims 1-23, 48-70, and 95** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

**Claims 1, 48, and 95** each recite the limitation "socially-relevant recommendation." The metes and bounds of this limitation are unclear to the examiner and the term also does not appear to be explicitly defined in the applicant's specification.

The examiner will apply prior art to these claims as best understood, giving the claim language its broadest reasonable interpretation, in light of the above rejections.

***Claim Rejections - 35 USC § 102***

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. **Claims 1-3, 6-16, 19-22, 48-50, 53-63, 66-69, and 95** are rejected under 35 U.S.C. 102(b) as being anticipated by **Robertson** (US 6,269,369).

In regards to **claim 1**, **Robertson** teaches a method, comprising:

- receiving data at a first node (**Robertson**; col. 13, lines 18-23; Fig. 14; *"if a first user lives in Boston but is traveling to New York on March 5, then the first user will be informed if any contacts will be crossing paths on that day in either city"*; Fig. 14 shows data being received at a node);

- creating a log entry in accordance with a match found between the data received at the first node and data held by a second node within a short-range communication range of the first node (**Robertson; Fig. 14; col. 16, Appendix A – shows matching; col. 20, Appendix I – a list constitutes a log of entries**); and
- providing a socially-relevant recommendation to a user of the first node relating to the data received at the first node after one or more criteria have been met, wherein the criteria include a specification of at least a predefined number of matches between the data received at the first node and data held by one or more other nodes encountered within the short-range communication range of the first node (**Robertson; Fig. 8; col. 13, lines 18-23 - “if a first user lives in Boston but is traveling to New York on March 5, then the first user will be informed if any contacts will be crossing paths on that day in either city” – constitutes a socially-relevant recommendation after one or more criteria are met; col. 14, lines 27-61; Fig. 12**).

In regards to **claim 2, Robertson** teaches the method of claim 1, wherein the data received at the first node includes at least an identifier for data held by the second node (**Robertson; col. 10, lines 54-61; col. 11, lines 50-59; Fig. 7; col. 14, lines 27-61; Fig. 12**).

In regards to **claim 3, Robertson** teaches the method of claim 2, wherein the identifier is a unique identifier (**Robertson; col. 16, lines 7-21**).

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In regards to **claim 6, Robertson** teaches the method of claim 2, wherein the data received at the first node includes a data element held by the second node (**Robertson; col. 4, lines 56-59; col. 11, lines 50-59; col. 14, lines 27-61; col. 16, lines 7-21**).

In regards to **claim 7, Robertson** teaches the method of claim 6, wherein the data element is a phone number (**Robertson; col. 11, lines 50-59; Fig. 7**).

In regards to **claim 8, Robertson** teaches the method of claim 6, wherein the data element is a universal resource locator (**Robertson; col. 16, lines 56-57**).

In regards to **claim 9, Robertson** teaches the method of claim 1, wherein the data received at the first node is not browsable by the user (**Robertson; col. 11, lines 50-59; col. 16, lines 56-57 – for example, although not displayed/"browsable", address id must have been sent in order to update the local PIM data**).

In regards to **claim 10, Robertson** teaches the method of claim 1, further comprising determining if the user already possesses data relating to the socially-relevant recommendation (**Robertson; Fig. 14**).

In regards to **claim 11, Robertson** teaches the method of claim 1, wherein the recommendation is provided at a particular period of time after the one or more criteria have been met (**Robertson; col. 11, lines 28-32; col. 14, lines 27-30**).

In regards to **claim 12, Robertson** teaches the method of claim 1, wherein the recommendation is provided at a particular time of day after one or more criteria have been met (**Robertson; col. 11, lines 28-32; col. 14, lines 27-30** – “particular time of day” is a broad limitation; since a recommendation is clearly provided at a particular time, that time at which the recommendation is provided is interpreted to be “the particular time of day”).

In regards to **claim 13, Robertson** teaches the method of claim 1, wherein the recommendation is provided after the user performs an operation with the first node (**Robertson; col. 5, lines 5-19; Fig. 7; Fig. 12**).

In regards to **claim 14, Robertson** teaches the method of claim 1, wherein the recommendation suggests to the user addition of data relating to the data received at the first node (**Robertson; Fig. 8**).

In regards to **claim 15, Robertson** teaches the method of claim 14, wherein the data suggested for addition is held by the second node (**Robertson; col. 10, lines 10-16; Fig. 14; col. 16, lines 7-21**).

In regards to **claim 16, Robertson** teaches the method of claim 1, wherein the first node employs short-range communication in communicating with the second node (**Robertson; Fig. 14**).



In regards to **claim 19**, **Robertson** teaches the method of claim 1, wherein one or more criteria provide for weighting of log entries (**Robertson; col. 20, Appendix I – certain matches/log entries are given higher/lower weight depending on permissions**).

In regards to **claim 20**, **Robertson** teaches the method of claim 1, wherein the recommendation is not provided after expiration of a validity period (**Robertson; col. 11, lines 28-32**).

In regards to **claim 21**, **Robertson** teaches the method of claim 1, wherein the data received at the first node is updated (**Robertson; col. 4, lines 42-45; Fig. 11**).

In regards to **claim 22**, **Robertson** teaches the method of claim 1, wherein the user is directed to a source for information regarding data suggested by the recommendation (**Robertson; Fig. 8; Fig. 11; Fig. 12 – the people listed are sources of information; col. 16, lines 56-57**).

**Claims 48-50, 53-63, and 66-69** are rejected with the same rationale given for claims 1-3, 6-16, and 19-22, respectively.

**Claim 95** is rejected with the same rationale given for claim 1.

*Claim Rejections - 35 USC § 103*

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

16. **Claims 17, 23, 64, and 70** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Robertson** in view of **Tsou et al.** (US 2002/0184089, hereinafter "Tsou").

In regards to **claim 17**, **Robertson** teaches the method of claim 16.

**Robertson** does not expressly teach employing IEEE 802.15.1 for the short-range communications.

**Tsou** teaches Bluetooth as an exemplary wireless communication protocol (**Tsou**; **par [0032]; par [0039]**).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to implement the method of **Robertson** using the Bluetooth communication protocol, as

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taught by Tsou, to send and receive information between wireless devices (**Tsou; par [0032]; par [0039]**).

In regards to **claim 23, Robertson** teaches the method of claim 1.

Robertson does not expressly teach an advertiser learning if the user complied with the recommendation.

**Tsou** teaches providing a wireless user with promotional advertisements and providing the advertiser with statistics regarding the effectiveness of those advertisements (**Tsou; par [0016] – par [0018]**).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to implement the method of Robertson, whereby users would be notified of promotional offers/recommendations from advertisers, and the advertisers would be notified of whether the users clicked on, i.e. complied with, the recommended promotions (**Tsou; par [0049]; par [0052]**).

**Claims 64 and 70** are rejected with the same rationale given for claims 17 and 23, respectively.

17. **Claims 18 and 65** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Robertson** in view of **Young et al.** (US 7,024,690, hereinafter "Young").

In regards to **claim 18, Robertson** teaches the method of claim 1.

Robertson does not expressly teach employing a one-way hash of a unique identifier associated with the second node in creating the log entry.

**Young** teaches employing one-way hashes of identifiers to enhance security of wireless communications (**Young; Abstract**).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to implement the method of Robertson, whereby the communication of data between the user nodes is made more secure by employing one-way hashing, as taught by Young (**Young; Abstract**). The data transmitted to/from the wireless clients of Robertson, which is then used in determining matches/log entries, would thereby be more trusted.

**Claim 65** is rejected with the same rationale given for claim 18.

18. **Claims 4 and 51** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Robertson** in view of **Bieganski et al.** (US 6,412,012, hereinafter "Bieganski").

In regards to **claim 4**, **Robertson** teaches the method of claim 2.

Robertson does not expressly teach the identifier being an international standard book number.

**Bieganski** teaches recommending books to users via international standard book number (ISBNs) based on matches with books already selected by the user (**Bieganski; col. 18, line 50 – col. 19, line 11**).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to implement the method of Robertson, whereby ISBNs are sent to a user to recommend books that may be of interest to the user (**Bieganski; col. 18, line 50 – col. 19, line 11**).

**Claim 51** is rejected with the same rationale given for claim 4.

19. **Claims 5 and 52** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Robertson** in view of **Spooner** (US 2005/0034099).

In regards to **claim 5**, **Robertson** teaches the method of claim 2.

Robertson does not expressly teach the identifier being an IMEI identifier.

**Spooner** teaches the use of a session specific identifier within a Symbian OS (**Spooner; par [0023]**).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to implement the method of Robertson using a Symbian identifier, as taught by Spooner, in order to check whether users or devices have the necessary rights to communicate (**Spooner; par [0023]**).

**Claim 52** is rejected with the same rationale given for claim 5.

*Response to Amendment*

20. Applicant's amendments filed 2/15/07 with respect to claims 5 and 52 have been fully considered. The previous objections to those claims have been withdrawn accordingly. However, the amendments have precipitated new objections to those claims, as detailed above.

***Response to Arguments***

21. Applicant's arguments filed 2/15/07 with respect to the 35 USC 112, 2<sup>nd</sup> paragraph rejections have been fully considered.

The rejections of claims 1, 48, and 95 that were based on the limitation "short-range" have been withdrawn in view of applicant's arguments.

The rejections of claims 5, 17, 52, and 64 have been withdrawn in view of applicant's amendments to those claims. However, the amendments to claims 17 and 64 have precipitated new 35 USC 112, 1<sup>st</sup> paragraph rejections, as detailed above.

The rejections of claims 1, 48, 95, and the claims depending therefrom, that were based on the limitation "socially-relevant recommendation" have been maintained. The examiner maintains that the metes and bounds of this limitation are unclear and the term also does not appear to be explicitly defined in the applicant's specification. The applicant has recited paragraphs of the specification to allegedly clarify the scope of the limitation. However, these paragraphs merely provide relative examples, i.e. what might constitute a more socially relevant recommendation when compared with another recommendation under specific circumstances. However, it is still unclear what constitutes a socially-relevant recommendation in the context of the claim language, even in view of the specification.

22. Applicant's arguments filed 2/15/07 with respect to the prior art rejections of the claims have been fully considered but they are not persuasive.

The applicant argues at pages 22-23 of applicant's remarks that the prior art does not teach data received at a first node and data held by a second node within a short-range communication range of the first node, and instead discusses functionality regarding information held at a server. The examiner respectfully disagrees with this argument. The examiner first asserts that Figure 14 of Robertson clearly shows "Client Computer A" and "Client Computer B" which are able to communicate with each other to meet the claimed limitations and could be interpreted as a first and second node. Furthermore, the examiner asserts that the applicant's specification does not appear to explicitly define the term "node" to exclude a server, which is certainly within the scope of the broadest reasonable interpretation of the term "node".

#### ***Conclusion***

23. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Kavita Padmanabhan** whose telephone number is **571-272-8352**. The examiner can normally be reached on Monday-Friday, 9:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Apu Mofiz can be reached on 571-272-4080. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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April 20, 2007

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